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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,081	07/10/2001	Richard E. Demaray	M-11522 US	1225
22852	7590	05/08/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			HOFFMANN, JOHN M	
		ART UNIT	PAPER NUMBER	
		1731		

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/903,081	DEMARAY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	John Hoffmann	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 2/28/2006.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 14-20, 24-27 and 29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 14-20, 24-27 and 29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Information Disclosure Statement***

The information disclosure statement filed 1 May 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the dates of publication (for non-patent documents are not provided.

#### **From MPEP 609(III) : The date of publication**

**supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue.**

It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e).

See MPEP § 609 ¶ C(1).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-20, 24-27, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not understood what is meant by a "separate step of etching the core layer" patterning the core layer" (as used in each independent claim). The specification fails to indicate what the step is "separate" from. It is noted in the response of 3/10/ 2005 applicant argued that Kawaguchi does not teach excluding the separate step. To Examiner, figure 7 of Kawaguchi does disclose this (see rejection). Since there is disagreement as to whether Kawaguchi discloses this limitation, it is deemed that it is proper to hold this as being indefinite. Furthermore, in the 5<sup>th</sup> to the last line, of page 9 of the 2/28/2006 response, applicant states that the core layer is not etched. However [0035]-[0038] discloses that the core layer is etched.

The meaning of "cover" is not understood. Applicant argues on page 12 of the Feb 28, 2006 response that Nourshargh does not cover the sidewall portion. As shown in Nourshargh's figure 2c, the sidewall is about 50% covered by the core layer 14. Applicant at paragraph [0038] uses the term "continuously covered"; this suggests that

something can be discontinuously covered. Such as what is shown in Nourshargh. Furthermore Applicant's figure 4B seems to show that the corner of the ridges 11P are in direct contact with the ambient – that they are not covered 100%. In summary: it is unclear if "cover" requires 100% coverage, or if something less suffices.

Claims 14-20, 24-27 and 29 rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 14-20, 24-27 and 29 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed 28 February 2006. In that paper, applicant has stated "the core layer is not etched", and this statement indicates that the invention is different from what is defined in the claim(s) because the claims merely require the absence of a separate step of etching and [0035] – [0038] discloses that etching does occur.

### ***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nourshargh 4619680.

See how Nourshargh was previously applied. Although the core layer is not shown to cover the sidewall portion completely, it does cover approximately 50% of the sidewall. It is noted that at paragraph [0038] of the specification, one of Applicant's embodiments has continuous coverage. Since the claims do not use the same language, it is presumed that applicant did not intend the claims to be limited to continuous coverage.

Claims 15-17, 24-26 and 29 (and 14) are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kawaguchi 6605228, Klein 3850604 , Nourshargh 4619680 and Weber as set forth below.

See how the references were previously applied.

Claim 17 : Examiner takes Official notice that radio waves of numerous frequencies permeate all space. It is inherent that these waves have power. Thus it is inherent that the second frequency power is applied. Since this Official Notice has been taken previously and not traversed by Applicant, such is now taken to be admitted prior art.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawaguchi 6605228 in view of Klein 3850604 and Kestigian 4915810.

See how the references were previously applied.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawaguchi 6605228 in view of Klein 3850604, Nourshargh 4619680 and Makikawa 6615614.

See how the references were previously applied.

***Response to Arguments***

Applicant's arguments filed 2/28/2006 have been fully considered but they are not persuasive.

As to the IDS's the deficiencies in the Office's prior considerations that applicant points to are remedied by the accompanying copies. Applicant correctly points out that many of the publications have the year but not the date. Examiner agrees. Examiner cannot make a patentability determination based on any evidence which lack a complete date which would permit a determination whether the references qualify as prior art. Therefore such references have not been considered.

IT is argued that [0008], [0014] and [0024] provide support for the limitation regarding etching. Whereas Examiner finds that those paragraphs provide basis for no etching, there is nothing which supports the language of "separate" portion. In other words, the claim only excludes "separate" etching. There is no basis for excluding only separate etchings. More importantly, there is no indication as to what the etchings can't be separate from. Applicant only argues that the core layer is not etched. Applicant does not point out how the "separate" language is definite or is provided for in the specification as originally filed.

Applicant also argues that the claim language does not have numerical ranges and therefore MPEP 2163.04 does not apply. This is not convincing. The rejection refers to the Purdue Pharma case. It is largely irrelevant whether the relevant principle (that an applicant cannot carve out a patentable portion that is not elsewhere provided for) is cited in the numerical range section of the MPEP. It does not make

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sense that one standard would apply to numerical limitations would never apply to other limitations. At a bare minimum applicant would need to provide some basis to show it is reasonable to carve out a patentable portion from an otherwise unpatentable invention.

It is also argued that Nourshargh does not cover the portions as recited in claim 14. The arguments do not point out why they are not covered. Examiner understands that Nourshargh does not have the identical coverage that Applicant's specific embodiment (fig 4b) has, but this is not very relevant the claims are not limited to the specific embodiment. Part of the sidewalls are shielded from exposure – thus to examiner they are partially covered. This is deemed to read on the claims. See discussions that points out that the present specification refers to continuous coverage – this suggest that there is coverage which can be discontinuous.

It is also argued that Nourschag teaches etching. This is largely irrelevant as that teaching pertains to a different embodiment. The Office has not taken the position regarding that embodiment. The rejection is based on the embodiment of figures 2 a-d.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus it does not matter that Klein and Kawaguchi (and the other secondary references) do not teach certain features: those features are elsewhere provided for in the rejection.

In response to applicant's argument that one cannot combine Kawaguchi and Nourshargh, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John Hoffmann  
Primary Examiner  
Art Unit 1731

4-18-06

jmh